



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Board of Patent Appeals and Interferences

In re Patent Application of

Atty Dkt. 3813-3

C# M#

WHITEHEAD

TC/A.U.: 3625

Serial No. 09/863,010

Examiner: Y. Garg

Filed: May 23, 2001

Date: September 28, 2006

Title: SERVICE SUBSCRIPTION SERVICE BUSINESS

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

☐ Correspondence Address Indication Form Attached.

☐ **NOTICE OF APPEAL**

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences  
from the last decision of the Examiner twice/finally rejecting  
applicant's claim(s).

\$500.00 (1401)/\$250.00 (2401) \$

☐ An appeal **BRIEF** is attached in the pending appeal of the  
above-identified application

\$500.00 (1402)/\$250.00 (2402) \$

☐ Credit for fees paid in prior appeal without decision on merits

-\$ ( )

☒ A reply brief is attached.

(no fee)

☐ Petition is hereby made to extend the current due date so as to cover the filing date of this  
paper and attachment(s)

One Month Extension \$120.00 (1251)/\$60.00 (2251)  
Two Month Extensions \$450.00 (1252)/\$225.00 (2252)  
Three Month Extensions \$1020.00 (1253)/\$510.00 (2253)  
Four Month Extensions \$1590.00 (1254)/\$795.00 (2254) \$

☐ "Small entity" statement attached.

Less month extension previously paid on

-\$ ( )

**TOTAL FEE ENCLOSED \$ 0.00**

Any future submission requiring an extension of time is hereby stated to include a petition for such time extension.  
The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or  
asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this  
firm) to our **Account No. 14-1140**. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYTE P.C.  
By Atty: Alan M. Kagen, Reg. No. 36,178

Signature: Alan M. Kagen



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**REPLY BRIEF**

In reply to the Examiner's Answer dated August 2, 2006, Appellant submits this Reply Brief under 37 C.F.R. §41.41.

On page 8 of the Examiner's Answer, the Examiner references step (c) of claim 1 arguing that since this is a "conditional statement implying that the user profile may or may not incorporate a best choice," if the best choice is not in the profile, "then step (c) claim is not relevant." Despite its conditional nature, at a minimum, the language requires that the user profile provide the user with an *option* to incorporate the automatic best choice service. This is an important feature of the invention that has been simply dismissed and ignored by the Examiner. At least this feature is lacking in the Herz publication.

The Examiner's reference to historical data relating to information about shoppers who have accepted a promotional offer still requires those shoppers to have accepted the offer. The Examiner's Answer contends that "the stored information related to shoppers having accepted a promotional offer reads on the claim limitation that the user profile incorporates an automatic best choice service." With reference to the discussion above and in the Appeal Brief, however, this contention evidences a misunderstanding of the claimed subject matter. The Examiner's Answer further contends that "the system in Herz identifies such offers from the database and informs the shopper about the availability of such offers which resulting in electronic ordering reads on the limitation that is automatically implementing the relevant items, and communicating the implemented relevant items to the user." Nowhere does the Herz publication, however, even remotely appreciate an ability to accept an offer without user intervention (i.e., to automatically implement identified relevant items).

The Examiner's Answer also reiterates the Examiner's misunderstanding of Appellant's point in describing the seller-driven system of the Herz publication. This point is addressed in the Appeal Brief.

On page 10 of the Examiner's Answer, the Examiner misquotes the language of claim 1 in an attempt to provide some basis for the misplaced conclusions. The Examiner maintains that claim 1 "does not teach automatically accepting the best offer." The Examiner references claim 1 as reciting "manipulative steps of compiling a user profile, accessing a database of items, automatically implementing the relevant items to the user if the user profile incorporates an automatic best choice service and communicating the

relevant items if the user profile does not incorporate an automatic best choice service.”

Emphasis added. Claim 1, however, does not include the phrase “to the user” with regard to the automatic implementation. The phrase “to the user” relates to communicating implemented items to the user if automatically implemented by the ABC service.

The Examiner’s Answer further concludes that “none of these steps expressly recite a function involving and automatically accepting a best offer by the user.” Claim 1, however, defines in step (c) the step of automatically implementing the relevant items if the user profile incorporates an automatic best choice service. The automatic implementation of the relevant items is indeed an express recitation of automatically accepting a best offer. The term “implement” in the claims is not used in a manner inconsistent with its ordinary meaning. Moreover, paragraph [0024] provides “If the ABC option is chosen by the customer, the service packages are automatically implemented, and the vendors are notified 60. Otherwise, the customer is notified 62 and provided with an opportunity to selectively implement identified relevant items.” Additionally, step (d) in claim 1 provides that if the user profile does not incorporate the ABC service, the method includes the step of communicating the relevant items to the user, and enabling the user to selectively implement the relevant items. From at least this description and related descriptions in the specification as well as the comparative language in the claims, Appellant submits that those of ordinary skill in the art would readily understand the meaning of the claim language.

The Examiner’s Answer repeats this misunderstanding on page 11, lines 1-7.

The dependent claims are addressed in the Appeal Brief.


WHITEHEAD  
Serial No. 09/863,010

For the reasons discussed herein and in the Appeal Brief, reversal of the final rejection is respectfully requested.

Respectfully submitted,

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